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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/904,516 | 07/16/2001 | Nathalie Mougin | P 0281573 B00/2208 US | 2271 |

909 7590 07/02/2003
PILLSBURY WINTHROP, LLP
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EXAMINER

SHARAREH, SHAHNAM J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1617

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/904,516

Applicant(s)

MOUGIN ET AL.

Examiner

Shahnam Sharareh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment filed on March 28, 2003 has been entered. Claims 1-33 are pending.
Any rejection that is not addressed in this Office Action is considered obviated.

Claim Objections

Claims 18-33 are objected to because of the following informalities: it is not clear what is meant by the limitation "L»group; L, L' and L»" in claims 18-33. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 18-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laine et al (US Pat. 4,617,341).

Applicant's arguments with respect to this rejection have been fully considered but are not found persuasive.

Applicant argues that PEG units of present invention are connected at both ends to a diisocyanate unit. (see Response at page 11). Examiner replies that this argument is not directed to the scope of the pending claims. As the initial matter, the rejection of record is based on the obviousness rationale. Accordingly, the rejection has been directed to a subgenus of compounds that encompass the elected compound of example 1. Thus, in view of the teachings of Laine, the elected compound has been declared obvious for the reasons of record. subsequently, Applicant's arguments that PEG unit is connected at both ends to a diisocyanate unit is not persuasive, because

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neither the generic claim 18, nor any dependent claims thereof are directed to such limitations. In fact, the instant claim I does not require the existence of any PEG unit, because when m in formula I is 0, no hydrophilic group is required to exist between the diisocyanate unit. Thus, such diisocyanate unit is directly linked to the alkylene radical of the quaternary nitrogen (see instant claims 18, 25). Similar results are true when n or p and m have the value of zero and L and L' are identical.

Applicant also argues that diisocyanate unit of the present invention is aliphatic. (see Response at page 11). Again, this argument is not directed to the scope of the pending claims, as there is not such requirement within the body of any of the pending claims. In fact, instant claim 26 states that R4 may comprise an unsaturated ring. Therefore, this argument is moot.

Applicant then argues that Terminal groups in the presently claimed invention are bound indirectly to a quaternary nitrogen via a diisocyanate unit. Again, this argument is not directed to the scope of the pending claims. Instant claim 26 describes the scope of the pending claims. Accordingly, functional groups R1-R3 can be directly bound to quaternary nitrogen.

Applicant finally argues that instantly claimed invention has greater than 4 carbons as the terminal alkyl group. This argument is not directed to the scope of the pending claims. The instant R and R' functional groups do not exclude aliphatic radicals of 1-4 carbons.

The polymers of Laine are in deed dispersible in water (see col 5, lines 13-25). Thus, the obviousness rejection over Laine is proper and is hereby maintained, because

all elements of the instant claims are taught and Applicant's arguments as a whole are not commensurate with the scope of the pending claims.

Election/Restrictions

Newly submitted claim 1-11, 13-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly added claim is directed to a distinct invention which is related water soluble amphiphilic cationic associative polyurethanes polymer. These sets of claims are not directed to the elected species as set forth in Paper No. 8. In fact they are polymeric moieties having divergent physical and chemical properties. Since the claimed polymer is not allowable, restriction is proper between said product and method of using. (MPEP, 806.05(I)).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP, 821.03.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 703-308-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200

ss
June 28, 2003